



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,827	06/13/2000	Sherry X. Guo	LIFE-008	7505
7590	06/16/2003			

Bret Field
Bozicevic Field & Francis LLP
200 Middlefield Road
Suite 200
Menlo Park, CA 94025

EXAMINER

GITOMER, RALPH J

ART UNIT PAPER NUMBER

1651

DATE MAILED: 06/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/593,827

Applicant(s)
Guo et al.

Examiner
Ralph Gitomer

Art Unit
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 5, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6-11, and 16-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-11, and 16-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Serial No. 09/593,827
Art Unit 1651

The amendment received 5/5/2003 has been entered and claims 1, 6-11, 16-27 are currently pending in this application. No priority is claimed, the filing date of this application is 6/13/2000.

In view of the arguments presented, the rejection of record of claims 1, 6-11, 16-23 under 35 USC 102(e) over Smith is hereby withdrawn. The rejection of record of claims 24-27 under 35 USC 103(a) over Smith is maintained. The rejection of record under 35 USC 112, second paragraph, is maintained. This Office Action is made non-final because the rejection of record under 35 USC 102(e) is now made under 102(a).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 6-11, 16-23 are rejected under 35 U.S.C. 102(a) as being anticipated by Smith.

See the Office Action of 3/8/2002 regarding the applicability of Smith.

Applicant's arguments filed 6/3/2002 have been fully considered but they are not persuasive.

Regarding the rejection of record, now withdrawn, under 35 USC 102(e), Applicants argue that Smith discloses a different
5 membrane and a different compound than those presently claimed.

It is the examiner's position that the teachings of Smith clearly encompass the presently claimed compound and matrix. See
column 12 Table 1 and claim 1 for the presently claimed dye, see
column 6 line 29 for polyamides for suitable matrix materials.

10

Applicant's arguments filed 6/3/2002 have been fully considered but they are not persuasive.

Regarding the rejection of record under 35 USC 103(a), Applicants argue that both the present application and the
15 reference were assigned to Lifescan at the time both inventions were made and therefor the reference is not a proper reference under 35 USC 103(a).

It is the examiner's position that the rejection was made under 35 USC 103(a), not 103(c) where 103(c) would not apply to
20 102(e), 102(f) or 102(g). The rejection under 103(a) properly applies to the above rejection as applied to 35 USC 102(a). No declaration has been made regarding the present application and the Smith reference, with a priority date of 4/4/1996, were commonly owned at the time the respective inventions were made.

25

Regarding the presently claimed kit directed to a test strip, a lance and a standard, no novelty is seen in such a kit.

Claims 6-10, 16-27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the following applies in all occurrences.

In claim 6 ~~system~~ is not understood in context; does it refer to an apparatus or composition? No system is seen.

Applicant's arguments filed 5/5/2003 have been fully considered but they are not persuasive.

Applicants argue that the specification describes systems.

It is the examiner's position that Applicants argument that those skilled in the art look to the patent specification rather than the claims to apprise themselves of its teachings borders on the frivolous. The principle is well established that the claims must be understandable and stand on their own.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (703) 308-0732. The examiner can normally be reached on Tuesday-Friday from 8:00 am - 5:00 pm. The examiner can also be reached on alternate Mondays. If attempts to reach the examiner by telephone are unsuccessful, the

Serial No. 09/593,827
Art Unit 1651

-5-

examiner's supervisor, Michael Wityshyn can be reached on (703)
308-4743. The fax phone number for this Art Unit is (703) 308-
4556. Any inquiry of a general nature or relating to the status
of this application should be directed to the Group receptionist
whose telephone number is (703) 308-1235. For 24 hour access to
patent application information 7 days per week, or for filing
applications electronically, please visit our website at
www.uspto.gov and click on the button Patent Electronic Business
Center for more information.

Ralph Gitomer

Ralph Gitomer
Primary Examiner
Group 1651

RALPH GITOMER
PRIMARY EXAMINER
GROUP 1200